REMARKS

Reconsideration of the above-identified application in view of the remarks and amendments following is respectfully requested. Claims 1-6, 8-11 and 13-19 are in this case. Claims 1-6, 8-11 and 13-19 have been rejected. Claim 14 has been amended.

Rejections over Double Patenting

The Examiner has rejected claims 1-6, 8-11 and 13-19 over double patenting with regard to US Patent No. 6,684,088. While continuing to traverse these rejections, Applicant has chosen to over the rejections and to expedite the prosecution by submitting a Terminal Disclaimer in compliance with 37 CFR 1.321(c) and which overcomes the Examiner's rejections is enclosed herewith.

35 U.S.C. § 102 Rejections – Pollack

The Examiner has rejected claims 14-15 and 17 over USC 102(e) as being anticipated by Pollack (US Patent No. 6,505,236). The rejections of the Examiner are respectfully traversed.

Pollack teaches a network based system for storing attachments of e-mail messages, and a method for storing such attachments. Attachments are stripped from received e-mail messages, and are stored on a network, such that they can later be accessed by the recipient of the e-mail message. The recipient of the message is notified of the location in which the attachment is stored by the appending to the sent e-mail message a handle connected to the attachment.

The object of the present invention is to provide a method and system for rapid downloading of e-mail messages containing encoded attachments by a user, by use of

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an e-mail proxy. The e-mail proxy itself receives the attachment from the e-mail

server, and can then provide the attachment to the recipient. Such rapid transmission

and downloading of e-mail messages containing attachments is obtained by

downloading only the information about the attachments, linking the information to a

formatted e-mail message which does not contain the attachment, and downloading

the attachment from the e-mail server to the proxy upon request or in the background.

The attachment is then decoded by the proxy, and is sent to the user upon request,

when the user presses the link appended to the e-mail message that was sent.

In the rejection of claims 14-15 and 17 the Examiner states that the claimed

subject matter is taught by Pollack, as Pollack teaches that the handle generator

receives the file name and location, which is interpreted by the Examiner as the

attachment information, as is seen in column 5 lines 17-19 of Pollack. In the lines

referenced by the Examiner Pollack teaches that after the attachments are downloaded

into the storage system, a file handle is generated using the file name and location:

"Handle generator 42 generates a handle 44 that corresponds to the filename 38 and

address 40 of the stored attachment 20' stored on storage device 26".

By contrast, the present invention as claimed in claim 14 has a number of clear

structural differences. For example, Pollack does not teach a separate e-mail server

and an e-mail proxy which receives the attachment, prepares a message concerning

the attachment for the recipient, and can then download the attachment to the

recipient's e-mail client. These functions are handled within a single body of Pollack,

which is clearly an e-mail server (see Figure 1). Furthermore, the handle generator of

Pollack has no connection to part of the e-mail server which receives and downloads

attachments (there is for example no connection between the handle generator and the

attachment retriever in Figure 1). By contrast, these functions are combined within

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the e-mail proxy of the present invention, which is clearly differentiated from the e-mail server. While continuing to traverse the rejections of the Examiner, this point has been further emphasized by amending claim 14, such that the e-mail proxy is now clearly described as receiving the attachment information and the attachment. Support for this amendment can be found throughout the text, including in Figures 1 and 2, and also on page 8, lines 11-20 of the application.

Also the present invention teaches optionally retrieving the attachment information before the attachment itself is downloaded from the e-mail server to the proxy. This is clear from page 10 lines 7-9 "optionally only the header information for the attachments is downloaded, while the attachments themselves are downloaded at a later point (for example, in the background)". Pollack does not teach or suggest such a possibility, and indeed the system of Pollack would not be capable of such a possibility, because all of the functions of Pollack are contained within a single e-mail server.

Thus, Applicant feels that claims 14-15 and 17 are novel and non-obvious over Pollack, and are therefore in condition for allowance.

35 U.S.C. § 103(a) Rejections – Pollack in view of Pizano

The Examiner rejected claims 1-6, 8, 10-11, 13 and 18 over USC 103(a) as being anticipated by Pollack in view of Pizano (US patent No. 6,105,055). The rejections of the Examiner are respectfully traversed.

The object of Pollack is given above.

The object of Pizano is to provide a multimedia collaboration system, which combines unique multimedia communications and media processing mechanisms, with components that support information sharing and distribution. The system

includes a delayed conference manager connected to a conference database, for archiving, maintaining and managing the information shared and the information related to each of the participating users of the system.

The Examiner states that Pizano teaches downloading e-mail messages and decoding any attachments before transmitting the message or attachment to the user, making reference to column 4, lines 46-47 of Pizano. However, the combination of Pollack and Pizano would be inoperative for a number of reasons.

For example, Pizano requires that a new e-mail message and a new "post" message must be sent, the former to the e-mail server and the latter to the newsgroup server (see col 4, lines 41-49). The e-mail message will only be downloaded and the attachment decoded if this condition is true. Since Pollack lacks any such paired messages, the direct combination (*without* any inventiveness on the part of one of ordinary skill in the art) of Pollack and Pizano would not permit decoding of e-mail attachments.

As another example, Pollack clearly indicates that all activity regarding receiving e-mail messages, parsing them and removing attachments occurs within an e-mail server (see for example Figure 1 of Pollack). Pizano also has a single e-mail server (see for example Figure 1 of Pizano). By contrast, the present invention (as recited in claim 1) features downloading an e-mail attachment from an e-mail server, and only then performing the functions required to send information to the recipient. Thus, there is a clear structural difference between the present invention and each of Pizano and Pollack, such that combining Pizano and Pollack would not result in the present invention as claimed in claim 1.

In addition, Pizano explicitly states that *first* the e-mail message is downloaded, and only then is the attachment decoded. By contrast, in the present

invention, the attachment is requested and decoded without any reference to the e-mail message. Thus, even if one of ordinary skill in the art would be permitted to be inventive, and to combine Pollack and Pizano, the resultant combination would not produce the present invention as claimed in claim 1.

Furthermore, although the Examiner has stated that "if the prior art structure is capable of performing the intended use, then it meets the claim", this requirement is not sufficient when combining two references in a rejection. Instead, one of ordinary skill in the art would also need to be motivated to provide such a combination. Applicant respectfully notes that not only would one of ordinary skill in the art *not* be so motivated, in fact the teachings of Pizano and Pollack would discourage such a combination. As noted previously, the decoding mechanism taught by Pizano is directed at a better storage mechanism, as is Pollack.

By contrast, the decoding taught by the present invention is used for reducing transmission time and bandwidth used, such that a recipient receiving an attachment will receive it in a decoded format, and such that the attachment can be sent and viewed in a streamed manner as it is already decoded. Decoding data according to the method of Pizano before sending it in the system taught by Pollack would not help in accelerating the transmission rate, or in saving bandwidth, as Pizano further teaches "newly arrived post will not be accessible at the DC manager 18 until the downloading and storing process is completely finished" (column 4, lines 52-54). Therefore, the combination of the two systems would not enable sending data in a streamed manner, and would not result in saving bandwidth or transferring time. Thus, one of ordinary skill in the art would be discouraged from such a combination.

Thus, Applicant feels that claims 1-6, 8, 10-11, 13 and 18 are novel and non-obvious over Pollack, and are therefore in condition for allowance.

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35 U.S.C. § 103(a) Rejections – Pollack and Pizano in view of Dowling

The Examiner rejected claim 9 over USC 103(a) as being unpatentable over Pollack and Pizano in view of Dowling (US Patent No. 6,574,239). The rejections of the Examiner as respectfully traversed

The object of Pollack is given above.

The object of Pizano is given above.

The object of Dowling is to provide a method for reconnecting a telephone modem with a reduced delay by reducing a time associated with retraining. This is achieved by saving a set of connection parameters which are retrieved when the modem is reconnected. Another method for reconnecting a telephone modem taught by Dowling is related to changes to the physical layers of the server.

The Examiner states that Dowling teaches background downloading of data that will not be used until later, while other processes are occurring. Applicant traverses these statements as follows. In the lines quoted by the Examiner Dowling teaches that the prediction according to which "background downloading" occurs is learned by observing the workflow habits of a user. However, in the teachings of the present invention the background downloading of attachments is performed regardless of the user habits, as the user is not required to be aware of such downloading.

Furthermore, since claim 9 depends from claim 1 and Applicant feels that claim 1 is in condition for allowance, claim 9 is therefore also novel and non-obvious over the above references, alone or in combination.

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35 U.S.C. § 103(a) Rejections – Pollack in view of Slotznick

The Examiner rejected claims 16 over USC 103(a) as being anticipated by Pollack in view of Slotznick (US patent No. 6,011,537). The rejections of the Examiner are respectfully traversed.

The object of Pollack is given above.

The object of Slotznick is to provide a system for displaying information at a display of a local user computer, such that the information includes primary information requested by a user, and secondary information including additional information not directly requested by the user.

The Examiner states that Slotznick discloses downloading primary and secondary information containing information about a file before downloading the actual full file. However, Slotznick teaches in the location referenced by the Examiner, column 26 lines 62-67 and column 27 lines 1-5, that primary information is downloaded prior to downloading secondary information, together with a 4K portion of the secondary information file, subsequently to which the rest of the secondary information file is downloaded.

It is clear that a user would be motivated to download the primary information, which was directly requested, before downloading secondary information. However, the primary information downloaded is not information regarding the secondary information file to be subsequently downloaded. Additionally, the 4K portion of the secondary information file that is downloaded is used to form a thumbnail or keyhole image of the secondary information. However, a keyhole image does not necessarily provide all the "metadata" type information which may be provided in an attachment header, such as the file size, location etc.

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Slotznick does not teach or suggest parsing an e-mail message to separate its components, but rather concerns downloading an "image" of a data file. Therefore, combining Slotznick and Pollack would not allow one of ordinary skill in the art to control the order of downloading an attachment as opposed to the original e-mail message. Thus the combination of Pollack and Slotznick would be inoperative and in any case would not result in the present invention.

Furthermore, since claim 16 depends from claim 1 and Applicant feels that claim 1 is in condition for allowance, claim 16 is therefore also novel and non-obvious over the above references, alone or in combination.

35 U.S.C. § 103(a) Rejections – Pollack in view of Ubowski

The Examiner rejected claim 19 over USC 103(a) as being anticipated by Pollack in view of Ubowski (US patent No. 6,618,758). The rejections of the Examiner are respectfully traversed.

The object of Pollack is given above.

The object of Ubowski is a system for downloading only a portion of a file through a network. The user is able to select which parts of the file to download based on characteristics of the data in the file.

By contrast, in the present invention, a clear separation is provided between an e-mail server and an e-mail proxy, as noted above. Also as noted above, the handle generator is not an e-mail proxy because it does not fulfill the same functions, and in any case Pollack only features an e-mail server (as described above).

Furthermore, Pollack requires both an e-mail message and a newsgroup message ("post") to be sent simultaneously in order for the process of preparing the e-mail message to occur, while Ubowski only teaches downloading parts of a single

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static file. Therefore, even assuming that one of ordinary skill in the art would be motivated to combine these references, the combination would not results in the present invention.

The combination of Pollack and Ubowski would therefore not result in the present invention as claimed in claim 19.

Thus, Applicant feels that claim 19 is novel and non-obvious over Pollack and Ubowski, alone or in combination.

In view of the above remarks and amendments it is respectfully submitted that claims 1-6, 8-11 and 13-19 are now in condition for allowance. Prompt Notice of Allowance is respectfully and earnestly solicited.

                                        Respectfully submitted,

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